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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,577	11/13/2000	John Calce	VIZR.10001NP	7169

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EXAMINER

SNAPP, SANDRA S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/711,577

Applicant(s)

CALCE ET AL.

Examiner

Sandra Snapp

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MLW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10, 12-20 and 24-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-10 are indefinite because it is unclear what is meant by the term “circuitry.” By using the term “circuitry” is the Applicant referring to the specific hardware needed in a computer system alone, or does it include associated software to operate the presently claimed method, or is it something else entirely? The Examiner briefly inspected the specification and was unable to find a definition of such. It is requested the Applicant clarify this issue, and provide specification support for such.

Claims 2 and 12 are indefinite because they state “multiple point of sale devices for receiving sales, gratuity and investment preference information” and claims 1 and 11 recite “receiving information regarding sales, and credit/debit gratuities” and it is unclear whether the information in claims 1 and 11 is the same information in claims 2 and 12. If so, the phrase “sales, gratuity and investment preference information” in claims 2 and 12 should be preceded by “the” or “said.” If not, then it should be amended to distinguish so there is no confusion.

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Claims 3 and 13 are indefinite because proper antecedent basis for the phrase “the account” has not been established. Since this is the first occurrence of the term “account” is should not be preceded by “the.”

Claims 7 and 17 are indefinite because the phrase “said money” is confusing. Is the money in claims 7 and 17 the same money as recited in claims 5 and 15 or is it different? If so, it should be distinguished so as not to cause confusion.

Claims 8 and 18 are indefinite because it is unclear from the phrase “one or more investment providers” whether the investment providers are the same as the one claimed in claims 1 and 11 or different. Clarification is required.

Claims 10 and 20 are indefinite because they do not have any positive recitation of structure (claim 10) and manipulative step (claim 20) that facilitates the desired result that is being claimed. In other words, while the claims are directed to enabling the employees to change from one employer to another, there is not any positive recitation of structure or a manipulative step being claimed in either claim that would facilitate such a change.

Claim 24 is indefinite because the term “employer” in line 6 on page 20 is confusing. Is it the current employer or the new current employer or a different employer?

Claim 26 is indefinite because the term “employees” in line 5 and the phrase “investments amounts” should both be preceded by “the” or “said” since both were previously recited in the claim.

Claims 4-6, 9, 14-16, 19 and 25 are indefinite because they depend from rejected base claims as stated above.

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***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 3-11 and 13-26, as understood, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1, 3-11 and 13-26 are directed to non-statutory subject matter because they lack any recitation of technology in the body of the claims, which is required in order to meet the statutory requirements. The Patent Office had taken the position that some form of technology must be claimed in the body of the claim. The Board of Patent Appeals and Interferences has stated that claims lacking any technology are “nothing more than [an] abstract idea which is not tied to any technological art and is not a useful art as contemplated by the Constitution.” *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) (Unpublished). While it is understood that the Bowman case is not precedential, it is cited herein for its content and reasoning.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-26 are rejected under 35 U.S.C. 102(e) as being anticipated by the Tarbox patent (US 6,154,732).

The Tarbox patent discloses an investment system, comprising:

Employer management circuitry (circuitry is inherent in a computer system as disclosed in Tarbox, col. 11, lines 24-44) for receiving information regarding sales and credit/debit gratuities for each participating employee of an employer (col. 4, lines 25-36 and Abstract), calculating settlement amounts for employees according to predefined preferences for withholding investment (col. 2, lines 47-64), and generating an investment database of investment amounts associated with the employees (col. 3, lines 20-27),

Account manager circuitry (circuitry is inherent in a computer system as disclosed in Tarbox, col. 11, lines 24-44) for: receiving the investment database (col. 3, lines 54-67), and coordinating investment of the investment amounts with an investment provider (col. 3, lines 42-53) (claim 1);

Multiple point of sale devices for receiving sales, gratuity and investment preference information at respective business locations and generating a location-specific

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investment database (col. 11, lines 24-44), and a main processor for consolidating the location-specific investment databases (col. 11, lines 24-44) (claim 2);

The account manager receives the investment database and generates a net investment amount to be credited to the accounts of the employees (col. 4, lines 44-48) (claim 3);

The net investment amount equals a total of investment amounts for all of the employees less a fee for each investment transaction (col. 11, lines 1-9) (claim 4);

The account manager communicates the net investment amount to a financial institution associated by the employer for transferring money in the value of the net investment amount to one or more investment providers (col. 11, lines 1-10) (claim 5);

The account manager transfers information to the one or more investment providers specifying how the money is allocated between the employees (col. 9, line 60 through col. 10, line 29) (claim 6);

The account manager receives money in the value of the net investment amount from the financial institution (col. 11, lines 1-10) (claim 7);

The account manager transfers the money to one or more investment providers (col. 11, lines 1-10) (claim 8);

The account manager transfers information to the one or more investment providers specifying how the money is allocated between the employees (col. 9, line 60 through col. 10, line 29) (claim 9); and

The employer management circuitry identifies each employee by an employer-independent account identifier, such that employees can change from one employer to another employer without changing the account identifier (col. 6, lines 55-61, such

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identification would allow the employee to access their account regardless of who their employer was) (claim 10).

The Tarbox reference discloses a method of investing money, comprising the steps of:

Receiving information regarding sales and credit/debit gratuities for each participating employee of an employer (col. 4, lines 25-36 and Abstract), calculating settlement amounts from employees according to predefined preferences for withholding investment amounts (col. 2, lines 47-64), generating an investment database of investment amounts associated with the employees (col. 3, lines 20-27), and coordinating investment of the investment amounts with an investment provider (col. 3, lines 42-53) (claim 11);

Receiving information at multiple point of sale devices for receiving sales, gratuities and investment preference information at respective business locations and further comprising the steps of generating a location-specific investment database and consolidating the location-specific investment database (col. 11, lines 24-44) (claim 12);

Generating a net investment amount to be credited to the accounts of the employees (col. 4, lines 44-48) (claim 13);

The net investment amount equals a total of investment amounts for all the employees less a fee for each investment transaction (col. 11, lines 1-10) (claims 14);

Communicating the net investment amount to a financial institution associated by the employer for transferring money in the value of the net investment amount to one or more investment providers (col. 11, lines 1-10) (claim 15);



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Transferring information to one or more investment providers specifying how the money is allocated between the employees (col. 9, line 60 through col. 10, line 29) (claim 16);

Receiving money in the value of the net investment amount from the financial institution (col. 11, lines 1-10) (claim 17);

Transferring the money to one or more investment providers (col. 11, lines 1-10) (claim 18);

Transferring information to the one or more investment providers specifying how the money is allocated between the employees (col. 9, line 60 through col. 10, line 29) (claim 19); and

Identifying each employee by an employer-independent account identifier, such that employees can change from one employer to another employer without changing the account identifier (col. 6, lines 55-61, such identification would allow the employee to access their account regardless of who their employer was) (claim 20).

The Tarbox patent discloses a method of investing money, comprising the steps of:

Initiating an account for an employee through a first employer (Abstract, and col. 4, lines 25-36), associating the account with the employee and the first employer (col. 1, lines 5-16 and col. 3, lines 42-53), receiving investment information from the first employer (col. 4, lines 25-36), directing the investment of funds provided by the first employer in accordance with the investment information (col. 2, lines 47-64), upon movement of the employee from the first employer to a second employer, associating the

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account with the employee and the second employer (col. 1, lines 5-16 and col. 6, lines 55-61, the identifier allows the employee to be associated with the account regardless of which employer they are working for) (claim 21);

The account has an identifier uniquely associated with the employee (col. 6, lines 55-61) (claim 22); and

The identifier is a social security number (col. 6, lines 55-61) (claim 23).

The Tarbox reference discloses a method of investing money, comprising the steps of:

Providing investment accounts for respective employees (Abstract and col. 1, lines 5-16), each employee having a current employer from a set of employers (Abstract and col. 1, lines 5-16), for each employee, receiving investment information from the employee's current employer specifying how withheld funds collected by the employee's employer should be invested (col. 1, lines 5-16 and col. 4, lines 25-36), wherein any employee can switch to a new current employer from said set of employers and continue to invest into the employee's respective investment account through the new current employer (col. 1, lines 5-16 and col. 55-61, such identification would allow the employee to access the account regardless of who the employer was) (claim 24); and

The current employer is associated with the employee's respective investment account (col. 1, lines 5-16 and Abstract) (claim 25).

The Tarbox reference discloses an investment system, comprising:

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Employer management circuitry (circuitry is inherent in a computer system as disclosed in Tarbox, col. 11, lines 24-44) for: receiving information regarding commissions for each participating employee of an employer (col. 4, lines 25-36 and Abstract), calculating settlement amounts for employees according to individual investment preferences for withholding investment amounts defined by the employees (col. 2, lines 47-64), and generating an investment database of investment amounts associated with the employees (col. 3, lines 20-27), and

Account manager circuitry (circuitry is inherent in a computer system as disclosed in Tarbox, col. 11, lines 24-44) for receiving the investment database (col. 3, lines 54-67), and coordinating investment of the investment amounts with an investment provider (col. 3, lines 42-35) (claim 26).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Musmanno, Atkins, Campbell, Manos, Melnikoff, Cristofich et al., Leon et al., Friend et al., Petruzzi, Edesess, Cwenar, Stein et al. and Higgins patents are all directed to various types of electronic investment and/or financial management systems.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SS

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